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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/091,718 | 03/06/2002 | Hiroyuki Chohsa | JP920000419US1 | 6846 |
| 33595 | 7590 | 06/15/2006 | | |
| INTERNATIONAL BUSINESS MACHINES CORPORATION 9000 SOUTH RITA ROAD TUCSON, AZ 85744 | | | | |
| | | | EXAMINER HUNTSINGER, PETER K | |
| | | | ART UNIT 2625 | PAPER NUMBER |

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/091,718 | CHOHSA ET AL. | |
| | Examiner | Art Unit | |
| | Peter K. Huntsinger | 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 8 and 9, filed 3/6/06, with respect to the rejection(s) of claim(s) 9 under Miyoshi et al. Publication 2001/0049703 and Mical Patent 4,772,882 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tanaka Patent 6,519,048, application's admitted prior art, and well known prior art.

Claim Objections

2. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation of claim 3 has been inserted into independent claim 1 and thus fails to further limit the claim.

3. Claims 12 and 13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims 12 and 13 are identical to claims 10 and 11 respectively.

4. Claim 14 is objected to because of the following informalities: The comma should be removed from line 2 of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication 2001/0049703, and further in view of application's admitted prior art, and well known prior art.

Referring to claim 1, Miyoshi et al. disclose a print instruction program, stored in a network terminal device outputting a print instruction to a printer linked to a communication network, for allowing said network terminal device to function as: a data control unit for controlling print data by obtaining mouse event data and file name data on a location where a mouse pointer is positioned (page 3-4, paragraph 44-45) from a plug-in unit that adds functions to a browser program (page 3, paragraph 41); a data accumulation unit for storing said file name data, wherein the data accumulation unit stores a plurality of PDF file names with their respective address data in a list form (control number display portion 184 of Fig. 3, page 3, paragraph 44); a data display unit for adding a print menu for a PDF file in a menu screen displayed in association with clicking of a mouse button (Fig. 3, page 3, paragraph 43), wherein the menu screen

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displays the plurality of PDF file names with-their respective address data (control number display portion 184 of Fig. 3, page 3, paragraph 44); and a data transmission unit for sending said tile name data to said printer (page 3, paragraph 45). Miyoshi et al. further discloses that web data may comprise PDF files (page 7, paragraph 91). Miyoshi et al. do not disclose expressly a printer that prints directly PDF files. The applicant's admitted prior art teaches a printer with a PDF direct printing function (pages 2-3). Miyoshi et al. and the applicant's admitted prior art are combinable because they are from the same field of printing systems. At the time of the invention, it would have obvious to a person of ordinary skill in the art to utilize a printer with a PDF direct print function in the invention of Miyoshi et al. The motivation for doing so would have been to reduce the time needed to print PDF files. Miyoshi et al. do not disclose expressly wherein the menu screen is displayed on a same browser screen that is displaying a PDF file. Displaying a print menu on an internet browser is well known and obvious in the art. This is a standard feature in Microsoft Internet Explorer and Netscape Navigator which both provide support for viewing PDF files. Miyoshi is in the same field of internet printing. At the time of the invention, it would have obvious to a person of ordinary skill in the art to display a print menu on a browser screen. The motivation for doing so would have been to allow fast and easy printing of an internet file.

Referring to claim 3, Miyoshi et al. disclose wherein said data accumulation unit stores a plurality of PDF file names with their respective address data in a list form (control number display portion 184 of Fig. 3, page 3, paragraph 44).

Referring to claim 5, Miyoshi et al. disclose wherein said direct print menu includes a menu item for displaying the list of the PDF file names stored in said data accumulation unit (Fig. 3, page 3, paragraph 43).

Referring to claim 7, Miyoshi et al. disclose wherein said data control unit checks the address data of the PDF files stored in said list, so that, for a file to be downloaded from a network address on the Internet, a URL of that PDF file is sent to said printer (step 1122 of Fig. 8, page 5, paragraph 70), and for a PDF file stored at a local address in said network terminal device, that PDF file is sent to said printer (step 1022 of Fig. 6, page 5, paragraph 63). Miyoshi et al. further discloses that web data may comprise PDF files (page 7, paragraph 91).

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication 2001/0049703, application's admitted prior art, and well known prior art, as applied to claim 1, and further in view of Berstis Patent 6,018,345.

Referring to claim 2, Miyoshi et al. discloses that web data may comprise PDF files but do not disclose expressly changing the mouse pointer to a PDF file specific form when it has determined that said file name data is of a PDF file. Berstis discloses changing the mouse pointer to a specific form when it has determined that file name data is a specific file, and wherein activation by the mouse pointer of the file specific form cause a menu screen to replace a display of the file specific form on the browser screen (steps 308 and 312 of Fig. 5, col. 6, lines 37-47). Miyoshi et al. and Berstis are combinable because they are from the same field of computer systems. At the time of

the invention, it would have been obvious to one of ordinary skill in the art to change a mouse pointer to a PDF specific form when located over a PDF file. The motivation for doing so would be to alert the user that a file is a specific type with further options available for the file. Therefore, it would have been obvious to combine Berstis with Miyoshi et al. to obtain the invention as specified in claim 2.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication 2001/0049703, application's admitted prior art, and well known prior art as applied to claim 3, and in further view of Otsuka Patent 5,579,126.

Referring to claim 4, Miyoshi et al. disclose a direct print menu but do not disclose expressly including a menu item for sequentially printing PDF files whose file names are included in the list stored in said data accumulation unit. Otsuka discloses sequentially printing documents from a list (col. 13, lines 22-26). Miyoshi et al. and Otsuka are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include a menu item for sequentially printing the list of PDF files. The motivation for doing so would be to allow the user to only select one menu item for printing a list of files opposed to having to select multiple menu items. Therefore, it would have been obvious to combine Otsuka with Miyoshi et al. to obtain the invention as specified in claim 4.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication US 2001/0049703, application's admitted prior art, and well known prior art as applied to claim 3, and in further view of Mical Patent 4,772,882.

Referring to claim 6, Miyoshi et al. disclose adding a PDF file name of a new print target at a bottom of the list of the PDF file names stored in said data accumulation unit (page 5, paragraph 60). Miyoshi et al. do not disclose expressly utilizing a menu item for adding a new file. Mical discloses utilizing a menu item for adding to a list (col. 9, lines 16-25). Miyoshi et al. and Mical are combinable because they are from the same field of computer systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include a menu item for adding files to a list. The motivation for doing so would be to provide a convenient method for adding to a list within a menu. Therefore, it would have been obvious to combine Mical with Miyoshi et al. to obtain the invention as specified in claim 6.

10. Claims 8, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka Patent 6,519,048, and further in view of application's admitted prior art, and well known prior art.

Referring to claim 8, Tanaka disclose a print instruction method for outputting a print instruction from a network terminal device to a printer linked to a communication network, comprising the steps of: checking whether a print target file specified by a mouse pointer on a browser screen is a PDF file (inherent, see below); checking whether the specified file is to be printed by pull printing, if the pull printing is indicated,

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reading a print menu screen (col. 9, lines 4-15), and if the pull printing is not indicated, the specified PDF file is downloaded and saved in the network terminal device by selecting a menu item for saving an object in a file on the print menu screen, and said specified PDF file is outputted to the printer (col. 9-10, lines 64-67, 1-15); storing a network address of the specified file by selecting a menu item to execute direct printing of a PDF file on the print menu screen (col. 9-10, lines 64-67, 1-15), and outputting the network address of the specified file to the printer (col. 9-10, lines 64-67, 1-15). While Tanaka does not disclose expressly checking whether a file is a PDF file, it is inherent in a computer that a computer recognizes a file type to know the corresponding program that is run to execute the file. Tanaka does not disclose expressly a printer that prints directly PDF files. The applicant's admitted prior art teaches a printer with a PDF direct printing function (pages 2-3). Tanaka and the applicant's admitted prior art are combinable because they are from the same field of printing systems. At the time of the invention, it would have obvious to a person of ordinary skill in the art to utilize a printer with a PDF direct print function in the invention of Tanaka. The motivation for doing so would have been to reduce the time needed to print PDF files. Tanaka does not disclose expressly reading a print menu screen by clicking a mouse while the pointer is kept specifying the file. Right clicking a file type and accessing a print menu option is well known in the art. This is a standard feature in Microsoft Internet Explorer and Netscape Navigator which both allow a user to right click an internet link which displays a menu option for printing. Tanaka is in the same field of internet printing. At the time of the invention, it would have obvious to a person of ordinary skill in the art to read a

print menu by clicking a mouse while specifying the file. The motivation for doing so would have been to allow fast and easy printing of an internet file.

Referring to claims 10 and 12, Tanaka disclose wherein the step of checking whether a print target file is a PDF file checks based on indication of a file name of the print target file. While Tanaka does not disclose expressly checking whether a file is a PDF file, it is inherent in a computer that a computer recognizes a file type to know the corresponding program that is run to execute the file.

11. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka Patent 6,519,048, application's admitted prior art, and well known prior art, as applied to claims 10 and 12, and further in view of Berstis Patent 6,018,345.

Referring to claims 11 and 13, Tanaka disclose checking based on the indication of a file name, but do not disclose expressly changing the mouse pointer to a PDF file specific form when it has determined that said file name data is of a PDF file. Berstis disclose a file specific mouse pointer is displayed in the vicinity of a file (steps 308 and 312 of Fig. 5, col. 6, lines 37-47). Tanaka and Berstis are combinable because they are from the same field of computer systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to change a mouse pointer to a PDF specific form when located over a PDF file. The motivation for doing so would be to alert the user that a file is a specific type with further options available for the file. Therefore, it would have been obvious to combine Berstis with Miyoshi et al. to obtain the invention as specified in claim 11 and 13.

12. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka Patent 6,519,048, application's admitted prior art, and well known prior art, as applied to claim 8, and further in view of Miyoshi et al. Publication 2001/0049703.

Referring to claim 14, Miyoshi et al. disclose wherein said step of storing the network address adds said network address to a bottom of a list of PDF files to be printed (page 5, paragraph 60).

Referring to claim 15, Tanaka disclose wherein when a network address of a specified PDF file is to be outputted to the printer by using the list of the PDF files to be printed, it is determined whether pull printing or push printing is performed, depending on the address of said specified PDF file which is either a network address or a local address (col. 9, lines 4-15).

13. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi et al. Publication 2001/0049703, and further in view of well known prior art.

Referring to claim 15, Miyoshi et al. disclose sending a network address of a browser screen to a menu screen (page 5, paragraph 60), wherein the menu screen is superimposed on the browser screen (both screens appear on the same display, a maximized browser screen would be superimposed by the menu screen of Fig. 3), and wherein the menu screen contains multiple network addresses (control number display portion 184 of Fig. 3, page 3, paragraph 44). Miyoshi et al. do not disclose expressly a print queue. Official Notice is taken that it is well known and obvious in the art to send

print jobs to a print queue (See MPEP 2144.03). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send print jobs to a print queue. The motivation for doing so would have been to create an ordered storage for handling received print jobs.

Referring to claim 16, Miyoshi et al. disclose wherein the browser screen displays a PDF file (page 7, paragraph 91).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH

A handwritten signature in black ink, appearing to be 'PKH' followed by a stylized flourish.A handwritten signature in black ink, appearing to be 'Twyler M. Lamb'.

Twyler M. Lamb
Supervisory Patent Examiner